

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventor : Kelly, D.P.
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For : METHOD AND SYSTEM FOR LINKING
LEGACY DVD DISCS TO RELATED WEB SITES

APPEAL BRIEF

On Appeal from Group Art Unit 2446

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, U.S. Philips Corporation, and not the party named in the above caption.

II. RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or interferences known to Appellant which will directly effect or be directly affected by or have a bearing on the Board's decision in this matter, Appellant is not aware of any such appeals or interferences.

III. STATUS OF CLAIMS

Claims 1, 3-11, 13, 14, 21, 23-31, 33 and 38-40 have been presented for examination. All of these claims are pending, stand finally rejected, and form the subject matter of the present appeal.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action, having a mailing date of May 1, 2009, Appellant timely submitted arguments to overcome the reasons for rejecting the claims. No Amendments were made to the claims. In reply, an Advisory Action, having a mailing date of July 29, 2009, was entered into the record. The Advisory Action stated that the amendments made to the claims raised new issues that would require a further

consideration. A copy of the claims is shown in the Claims Appendix, below. The Advisory Action stated that the amendments made to the claims in response to the Final Office Action would not be entered. The Advisory Action provided additional rationale for maintaining the rejection of the claims in reply to the Applicant's arguments presented in the response to the Final Office Action.

A Notice of Appeal was timely filed in response to the Advisory Action and this Appeal Brief is being timely filed, with appropriate fee, within the period of response from the date of the Notice of Appeal.

A copy of the claims presented, herein, are, thus, those claims of record upon which the Final Office Action is based.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is expressed primarily in independent claims 1 (a player) and 21 (a method). Independent claim 1 recites a web based DVD player (10, Figure 1; 32, Figure 2), in communication with a web server 25 via a network (internet). When a DVD disc 20 is placed in the DVD player 10 a local data base (not shown), including a plurality of universal resource locators associated with corresponding ones of a plurality of websites associated with corresponding content provides is accessed. The data base further includes means for deriving a title identification of a legacy DVD disc. In accordance with one aspect of the invention, after the disc is loaded into the player (32, Figure 2), the player reads the provider unique identification (40, Figure 2) from the disc and uses the provider unique identification to find a Universal Resource Locator (URL) of the associated content provider from a URL list (42, Figure 2). The URL of the content

provider is indexed to a table which contains a list of some popular title identifications of the discs produced by the content provider. (48, Figure 2) and a location containing an indication of a method of deriving the popular title identification, and a URL of a related web site. The player then attempts to derive the popular title identification of the disc in accordance with the method specified in the table (50, Figure 2) and compares the derived popular title identification (54, Figure 2) with the data in the popular title identification column of the table to find the corresponding URL for locating the specific web pages of the content provider (58, Figure 2).

Independent claim 21 recites a method for linking a legacy DVD disc to a related web site comprising the steps of populating a local database to include at least a plurality of universal resource locators (URLs) associated with corresponding ones of a plurality of websites associated with corresponding ones of a plurality of content providers, a plurality of expected title identifications associated with corresponding ones of said plurality of content providers, a list of methods for deriving a title identification, said methods consisting of at least one of a read operation and an algorithmic; deriving a title identification of the disc (50, Figure 2), the popular title identification being a unique identifier of a title of the disc, wherein the popular title identification is derived in accordance with one of said methods specified in the database (50, Figure 2); and linking the disc to a related web site based on the derived popular title identification (58, Figure 2).

The remaining claims, which depend from respective independent claims, express further aspects of the invention.

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The issues in the present matter are whether:

1. Claims 1-5, 8-25 and 28-40 are unpatentable under 35 USC §102(e) as being anticipated by Siah (International Patent Application Publication no. WO 02/15024), and;
2. Claims 6-7 and 26-27 are unpatentable under 35 USC §103(a) as being unpatentable over Siah in view of Official Notice.

In addition, claims 1, 3-5, 8-11, 13, 14, 21, 23-25, 28-31 33 and 38-40 are objected to for including informalities. However, these informalities are principally typographical errors and not material to the issues presented.

VII. ARGUMENT

I. Rejection of claims 1-5, 8-25 and 28-40 under 35 USC §102

The rejection of claims 1-5, 8-25 and 28-40 as being anticipated under 35 USC §102(e) by Siah is in error because the reference fails to disclose a material element recited in the claims.

Summary of the Rejection of the Claims

The Final Office Action rejected the claims referring to Siah for teaching each of the elements of the independent claims including a local data base (that may be stored in a flash memory 219 or in an additional memory, e.g., a hard drive), including a plurality of websites associated with corresponding ones of a plurality of content providers, a plurality of expected title identifications associated with corresponding ones of said plurality of content providers, a list of methods for deriving a title identification, the methods consisting of at least one of a read operation and an algorithmic operation,

and means for deriving the title identification of a legacy DVD and means for linking the disc to a related website.

The Final Office Action, in reply to Applicant's prior arguments regarding the database including methods for determining a DVD signature, further asserts that "none of the claims include a limitation of determining a DVD signature. However, assuming the title identification of a DVD can be equated with a DVD signature, Siah discloses a method for determining the DVD signature/identification (see page 11, lines 16-17). (see page 2, Final OA)."

The Advisory Action, in maintaining the rejection of the claims in view of arguments presented in Applicant's response to the Final Office Action, asserts that Siah teaches at least two methods for deriving title identification (see page 11, lines 16-17 and page 15, lines 5-6). (see AA, page 2)

The Advisory Action further states, in reply to applicant's argument, that Siah does not teach a means for deriving a title identification, however, such a means is inherent in the hardware and methods disclosed in Siah." id.

**Difference between the Claimed Invention
Recited in the Independent Claims
and the Cited References**

The instant invention, as recited in claim 1, for example, teaches a web based DVD player that allows for the playing of content on legacy DVD discs by determining a title identification of the disc content and using the title identification to determine a web based address at which the information regarding the DVD content may be found and accessed. In determining a title identification, a local data base is accessed which includes information regarding web based addresses (Universal Resource Locators)

associated with content providers, expected titles associated with each of the content providers and a list of methods for deriving the title identification. The method of deriving the title information may be either one that is a read operation or an algorithmic operation. The methods for determining the title identification are stored on the disc.

Siah discloses a system including a DVD client device that determines a DVD signature from navigation information read from a DVD and provides the determined DVD signature to a DVD information server that is used to identify particular web content that relates to the DVD. The web content may include promotional material specific to the DVD. Siah in addition discloses that the DVD signature is used to access a local data base that may include a record corresponding to the DVD (see page 11 and the description associated with Figure 11). If a record associated with the DVD signature is not found, then the DVD signature is provided to a DVD server to update the information in the local data (see, for example, page 11, line 7). The updated information includes URL values (see page 11, line 24).

Siah further discloses that different DVD signatures may be stored for the same DVD title (see page 14, line 3). The different DVD signatures may be used in different regions or to identify different version of the content of the DVD within a same region.

Siah further discloses two different methods of determining the DVD signature. The different methods relate to using information from the C-PBIT field. (see Figure 13 and 14). In addition Siah states that "[a] myriad of possible calculations including but not limited to other calculations based on Boolean and arithmetic operations on navigation data, preferably C-PBIT data are possible." (see page 15, lines 25-27).

However, while Siah may disclose that calculations may be possible to determine a signature, Siah is silent with regard to these methods of determining title identification (which is assumed comparable to the DVD signature of Siah) being included in the local database, as is recited in the claims.

Siah Fails to Anticipate the Claimed Invention

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

The Advisory Action, in maintaining the rejection of the claims, refers to page 11, lines 16-17 (“[i]n process block 806, a unique DVD signature for the DVD is calculated based on the DVD navigation information, preferably, the C-PBIT.”) and page 15, lines 5-6 (“FIG. 14 is a flow chart of a second process 1400 for calculating a DVD signature based on information read from a DVD C-PBIT.”) of Siah for teaching at least two methods for deriving title identification and that it is inherent from the hardware and methods disclosed by Siah that a means for deriving a title identification is taught by Siah.

Contrary to the position stated in the Advisory Action, Siah fails to disclose that the methods for deriving title identification are contained within the local data base. Rather Siah merely discloses that methods for deriving title identification are known and utilized on navigation data found in the C-PBIT to determine a signature. Siah does not disclose that the method(s) is(are) contained in the local data base, as is recited in the claims.

Accordingly, Siah cannot anticipate claim 1, as Siah fails to disclose each and every element recited in claim 1.

With regard to the remaining independent claim 21, these claim recites subject matter similar to that recited in claim 1 and have been rejected citing the same references used in rejecting claim 1. Hence, the arguments presented in response to the rejection of claim 1, herein, are applicable to the rejection of the claim 21 and reasserted, as if in full, herein.

For the arguments presented herein, Applicant submits that Siah cannot be said to anticipate the independent claim 21, as Siah fails to disclose every element recited therein.

Thus, each of the independent claims is patently distinguishable and allowable over the cited reference.

With regard to the remaining claims, these claims depend from the independent claims. Applicant respectfully submits that these claims are allowable at least for their dependence upon allowable base claims, without even contemplating the merits of the dependent claims for reasons analogous to those held in *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

In view of the above, applicant submits that the independent claims, and the claims dependent therefrom, are patently distinguishable and allowable over the teaching of Siah.

2. Rejection of claims 6-7 and 26-27 under 35 USC §103(a)

The rejection of claims 6-7 and 26-27 as being rendered obvious under 35 USC §103(a) by the combination of Siah and Official Notice is in error because the references, when combined, fail to show an element cited in independent claims from which claims 6-7 and 26-27 depend.

Claims 6-7 and 26-27 Depend From an Allowable Base Claim

Claims 6-7 and 26-27 depend from independent claims 1 and 21, respectively, which has been shown to include subject matter not disclosed by Siah. The Final Office Action refers to Official Notice for teaching that a burst cutting area or a private data sector, which is the subject matter of the aforementioned claims, are well known in the art. However, the Official Notice taken with regard to a burst cutting area or a private data sector fails to provide any teaching to correct the deficiency found to exist in Siah, and consequently, in the aforementioned dependent claims.

Appellant respectfully submits that claims 6-7 and 26-27 are allowable at least for their dependence upon an allowable base claim for the reasons held in *In re Fine*, (citation omitted) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

In view of the above, Appellant submits that the above referred-to claims are patentable over the teachings of the cited references.

In addition, in order to establish a *prima facie* case of obviousness, generally three basic criteria must be met;

1. there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;

2. there must be a reasonable expectation of success; and

3. the prior art reference must teach or suggest all the claim limitations. The **teaching or suggestion** to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck* (citation omitted). (emphasis added).

In addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a "helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM test is not to be applied in a rigid manner. Rather, the Court favored a more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements.

**The Combination of the Cited References
Fails to Disclose all the Elements Recited in the Claims**

The combination of the Siah and Official Notice fails to disclose all the elements recited in the claims as the Official Notice referred to fails to provide any motivation to incorporate the methods of deriving a title signature onto the disc.

For at least the above reasons, Appellant respectfully submits that a case of obviousness has not been set forth.

In view of the above, Appellant submits that the independent claims and the claims dependent therefrom are not rendered obvious over the teaching of the cited references.

VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fail to render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

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IX. CLAIMS APPENDIX

1. A WebDVD player, comprising:
 - a local database including at least a plurality of universal resource locators (URLs) associated with corresponding ones of a plurality of websites associated with corresponding ones of a plurality of content providers, a plurality of expected title identifications associated with corresponding ones of said plurality of content providers, and a list of methods for deriving a title identification, said methods consisting of at least one of a read operation and an algorithmic operation;
 - means for deriving a title identification (TitleJD) of a legacy DVD disc, the TitleJD being a unique identifier of a title of the legacy DVD disc, wherein the TitleJD is derived in accordance with one of said methods specified in the database; and
 - means for linking the disc to a related web site based on the derived TitleJD.
2. (Cancelled).
3. The player of claim 1, further comprising means for determining whether the derived TitleJD matches an expected title identification value indicated in the database that is associated with the specified method.
4. The player of claim 1, further comprising means for retrieving a universal resource locator (URL) in the database that is associated with the expected title identification value if the derived TitleJD matches the expected title identification value.
5. The player of claim 1, wherein said method of deriving the TitleJD comprises reading a unique identifier from a pre-selected location of the disc.
6. The player of claim 5, wherein the pre-selected location is a burst cutting area (BCA).

7. The player of claim 5, wherein the pre-selected location is a private data sector.
8. The player of claim 1, wherein said method of deriving the TitleJD comprises reading a Volume Set ID in a Universal Disc Format (UDF) file system of the disc.
9. The player of claim 1, wherein said method of deriving the TitleJD comprises reading selected data available on the disc.
10. The player of claim 1, further comprising:
means for retrieving a provider unique identification (PVRJD) from the disc;
wherein the TitleJD is derived based on the retrieved PVRJD of the disc.
11. The player of claim 10, further comprising:
means for determining whether the retrieved PVRJD matches a corresponding URL in the list; and
means for searching through the title identifications in the table that are associated with the corresponding URL for finding a matching TitleJD.
12. (Cancelled)
13. The player of claim 12, wherein if the derived TitleJD fails to match any expected title identification in the table, the linking means links the disc to a general web site of a content provider using the corresponding URL.
14. The player of claim 12, further comprising:
means for accessing a source web site, if the derived TitleJD does not match any expected title identification in the table, the source web site containing a database which includes a list of universal resource locator (URL) links to related web sites and their associated PVRJD and TitleJD;
means for searching a corresponding URL in the source web site database based on the retrieved PVRJD and derived TitleJD; and

means for linking the disc to a related web site using the corresponding matching URL.

15. -20 (Cancelled)

21. A method for linking a legacy DVD disc to a related web site, the method comprising the steps of:

populating a local database to include at least a plurality of universal resource locators (URLs) associated with corresponding ones of a plurality of websites associated with corresponding ones of a plurality of content providers, a plurality of expected title identifications associated with corresponding ones of said plurality of content providers and a list of methods for deriving a title identification, said methods consisting of at least one of a read operation and an algorithmic;

deriving a title identification (TitleJD) of the disc, the TitleJD being a unique identifier of a title of the disc, wherein the TitleJD is derived in accordance with one of said methods specified in the database; and

linking the disc to a related web site based on the derived TitleJD.

22. (Cancelled)

23. The method of claim 21, further comprising the step of determining whether the derived TitleJD matches an expected title identification value indicated in the database that is associated with the specified method.

24. The method of claim 21, further comprising the step of retrieving a universal resource locator (URL) in the database that is associated with the expected title identification value if the derived TitleJD matches the expected title identification value.

25. The method of claim 21, wherein said method of deriving the TitleJD comprises reading a unique identifier from a pre-selected location of the disc.

26. The method of claim 25, wherein the pre-selected location is a burst cutting area (BCA).
27. The method of claim 25, wherein the pre-selected location is a private data sector.
28. The method of claim 21, wherein said method of deriving the TitleJD comprises reading a Volume Set ID in a Universal Disc File (UDF) file system of the disc.
29. The method of claim 21, wherein said method of deriving the TitleJD comprises reading selected data available on the disc.
30. The method of claim 29, further comprising the steps of:
retrieving a provider unique identification (PVRJD) from the disc;
wherein the TitleJD is derived based on the retrieved PVRJD of the disc.
31. The method of claim 30, further comprising the steps of:
determining whether the retrieved PVRJD matches a corresponding URL in the list; and
searching through the TitleJD in the table that are associated with the corresponding URL for finding a matching TitleJD.
32. (Cancelled)
33. The method of claim 32, further comprising the steps of:
accessing a source web site, if the derived TitleJD does not match any expected title identification in the table, the source web site containing a database which includes a list of universal resource locator (URL) links to related web sites and their associated PVRJD and TitleJD;
searching a corresponding URL in the database based on the retrieved PVRJD and derived TitleJD; and
linking the disc to a related web site using the corresponding matching URL.

34. -37. (Cancelled)

38. The player of claim 14, further comprising means for periodically updating the database and the table stored by the storing means with information from the source web site.

39. The player of claim 14, further comprising means for caching an address of a website address each time the web site is accessed.

40. The player of claim 14, further comprising means for allowing a user to manually update the database and the table stored by the storing means with new information.

X. EVIDENCE APPENDIX

No further evidence is submitted herein.

XI. RELATED PROCEEDING APPENDIX

No related proceedings are pending and, hence, no information regarding same is available